

## REMARKS

Claims 8-10 and 24-26 are pending in the application. As required by 37 CFR § 1.121, Applicants submit a version with markings showing changes to the application. In light of the amendments and following remarks, Applicants believe all the pending claims are now in condition for allowance.

### Formal Matters

The Office Action indicated that although the specification is acceptable for examination purposes, it may not be suitable for printing if the patent issues. As the parent application issued as U.S. Patent No. 6,130,046, it is hoped that the Patent Office can utilize the entered text from that application when the subject application issues. Therefore, Applicant respectfully requests that the rejection be reconsidered. In any event, Applicant would like to defer addressing this rejection until the subject application is otherwise in condition for allowance.

Claim 9 was rejected under 35 USC § 112, second paragraph, as allegedly being indefinite. More specifically, the Office Action asserted that the word "near" was a relative term. Although Applicant believes the claim is sufficiently definite, in a sincere effort to expedite prosecution, Applicant has deleted the word from the claim so the rejection is overcome.

### The § 102(b) Rejection of Claims 8-10

The Office Action rejected claims 8-10 under 35 USC § 102(b) as allegedly being anticipated by "'Checkerboard' DNA-DNA Hybridization," published 1994 by S.S. Socransky et al. (hereinafter "Socransky"). Accordingly, it is asserted that the reference discloses all the features of the claims. For the following reasons, Applicant respectfully traverses the rejection.

Socransky has not been shown to describe a substrate including polymer probes having the same sequence that are formed with at least one different monomer addition cycle as claimed. For example, claim 8 recites the following:

a plurality of regions on the substrate in which polymer probes having the same sequence are coupled, wherein the polymer probes having the same sequence will bind with a control sequence of monomers but are formed with at least one different monomer addition cycle so that the integrity of the polymer probes may be verified.

(emphasis supplied). The Office Action does not show where Socransky discloses the feature of polymer probes having the same sequence that are formed with at least one different monomer

addition cycle recited in claim 8. Therefore, a prima facie case of anticipation has not been established.

The Office Action addresses this feature and asserts that the feature is a "product by process type" type limitation. Applicant appreciates the Examiner's citation of MPEP 2113. However, even assuming for the sake of argument that claim 8 is a product by process claim as alleged, the MPEP states case law reaffirms the patentability of such a claim resides in the product itself, not the process (see, e.g., In re Thorpe, 227 USPQ 964, 966 (Fed. Cir. 1985)). As stated in the MPEP, if the end product of a product by process claim and a product of the prior art are the same, the claim is not patentably.

With the subject application, the product of the claims (the substrate) is not the same as the product described in Socransky. The Socransky reference has not been shown to describe a substrate that includes polymer probes having the same sequence that are formed with at least one different monomer addition cycle as claimed. The different monomer addition cycles make the resulting product different than has been shown in the cited art. As an example, FIG. 12 of the subject application shows that different monomer addition cycles can result in drastically different hybridization results. When, as here, the product of the claims is not the same as the product in the cited reference, it must be shown where a cited reference discloses the features in order to establish a prima facie case of anticipation.

#### Conclusion

For the foregoing reasons, Applicant believes all the pending claims are in condition for allowance and should be passed to issue. If the Examiner feels that a telephone conference would in any way expedite the prosecution of the application, please do not hesitate to call the undersigned at (408) 446-8693.

Respectfully submitted,



Michael J. Ritter  
Reg. No. 36,653

RITTER, LANG & KAPLAN LLP  
12930 Saratoga Ave., Suite D1  
Saratoga, CA 95070  
Tel: 408-446-8690  
Fax: 408-446-8691

**VERSION WITH MARKINGS TO SHOW CHANGES  
MADE TO THE APPLICATION**

In the Claims

Claims 1-7 and 11-23 were canceled without prejudice, claims 24-26 were added and claim 9 was amended as follows:

9. (Amended) The substrate of claim 8, wherein the plurality of regions are at **[near]** the center of the substrate.

24. (New) A substrate having nucleic acid probes coupled thereto, comprising:  
a plurality of regions on the substrate in which diverse nucleic acid probes are coupled;  
and

a plurality of regions on the substrate in which nucleic acid probes having the same sequence are coupled, wherein the nucleic acid probes having the same sequence will bind with a control sequence of nucleotides but are formed with at least one different nucleotide addition cycle so that the integrity of the nucleic acid probes may be verified.

25. (New) The substrate of claim 24, wherein the plurality of regions are at the center of the substrate.

26. (New) The substrate of claim 24, wherein the plurality of regions are in a checkerboard pattern on the substrate.